

**IN THE MATTER OF AN OPPOSITION  
by Novopharm Ltd. to application no.  
699,918 for the trade-mark TABLET  
DESIGN (Red-brown) filed by  
Astra Aktiebolag (formerly Aktiebolaget Astra)**  
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On February 28, 1992, the applicant, Astra Aktiebolag, filed an application to register the mark TABLET DESIGN (Red-brown) based on proposed use in Canada in association with “pharmaceutical preparations namely, felodipine.” The mark is described in the application as shown below:

Three specimens of the subject mark are found in an envelop located on the inside back cover of the subject file. The subject mark was advertised in the *Trade-marks Journal* issue dated July 14, 1993 after the applicant had overcome objections to the application raised at the Examination stage. The opponent, Novopharm Ltd., filed a statement of opposition on September 14, 1993, a copy of which was forwarded to the applicant on November 18, 1993. The grounds of opposition are reproduced below.

The applicant responded by filing and serving a counter statement. The counter statement denies each of the grounds of opposition and pleads that, in respect of (a) above, “These grounds of opposition are speculative or incorrect;” in respect of (b) above, that the “statement of opposition does not contain sufficient detail to enable the applicant to reply thereto . . . ;” and in respect of (c) above, that “the shape and particular drug of any tablet referred to . . . are not set out and accordingly it is not possible to fully respond thereto.”

The opponent’s evidence consists of the affidavits of Drs. Marcia Joseph and Thomas Weinberger; and Philip Droznika and Karen Hilary Groyeski, pharmacists. The applicant’s evidence consists of the affidavit of Stephen Wilton, an executive employed by a wholly owned subsidiary of the applicant. I note that my ruling of February 14, 1996 in the subject file appears to treat Mr. Wilton’s evidence as additional evidence filed pursuant to Section 44 (then Section 46) of the *Trade-marks Regulations* rather than as evidence in chief. Upon review of the file, it is apparent that my February 14 characterization of the applicant’s evidence is in error, the mistake likely resulting from circumstances existing in a closely related file (application no. 699,917) involving the same parties and common evidence. In any event, I do not believe that either party has been prejudiced by this error. All of the above-mentioned individuals were cross-examined on their affidavits, the transcripts thereof, exhibits thereto, and replies to undertakings forming part of the evidence of record. Both parties filed a written argument and both parties were

represented at an oral hearing.

With respect to the ground of opposition denoted by (a)(i) above, the applicant submits that the opponent has not provided any facts to explain why the applied for trade-mark is not a trade-mark. The applicant therefore contends that the opponent's pleading contravenes Section 38(3)(a) of the *Trade-marks Act* which requires a ground of opposition to be set out in sufficient detail to enable the applicant to reply thereto. I agree with the applicant: see, for example, *Novopharm Ltd. v. Hoechst Aktiengesellschaft* 1997, 76 C.P.R.(3d) 257 at 261(TMOB).

With respect to the ground of opposition denoted by a(ii) above, the application does in fact include a drawing namely, two perspectives of the applied for mark. Further, the drawings, together with the written description of the mark and specimens on file, are adequate to describe the mark: see *Novopharm Ltd. v. Bayer* 1996, 76 C.P.R. (3d) 560 at 566-567 (TMOB); *Novopharm Ltd. v. Glaxo Wellcome* (May 28, 1999, yet unreported, at p. 6, (TMOB)). Thus, the ground of opposition denoted by a(ii) is rejected.

With respect to the second ground of opposition denoted by (b) above, the applicant argues as follows at paragraphs 32 and 54 of its written argument.

I am in general agreement with the applicant's submissions. In particular, Section 17(1) of the *Act* requires that an opponent who alleges non-entitlement must rely on its own use of a confusing mark, not on use of a confusing mark by third a party: see *Professional Pharmaceutical v. Laboratoires Ed. Fromont, S.A.* (1996), 69 C.P.R.(3d) 501 at 508-509 (TMOB). In any event, at the oral hearing counsel for the opponent withdrew the second ground of opposition.

With respect to the third ground of opposition denoted by (c) above, the applicant argues as follows at paragraph 33 of its written argument.

Again, I must agree with the applicant. In my view, the applicant should not be faced with the burden of investigating what products are sold by third parties in an attempt to discover which red-brown tablets the opponent may possibly be referring to. If I am wrong in this, then I find that the opponent has not supported the allegations in the statement of opposition. That is, there is no quantitative evidence, and insufficient qualitative evidence, of sales or use of any pharmaceutical tablets which have a colour and shape combination resembling the applied for mark.

I would add that at the oral hearing counsel for the opponent vigorously pursued the issue of non-distinctiveness of the applied for mark based on marketplace use of pharmaceutical tablets not cited or alluded to in the statement of opposition, and based on allegations of improper licencing of the applied for mark to Hoechst-Roussell Canada Inc., also absent from the opponent's pleadings. In respect of the above, the opponent's arguments were based on Stephen Wilton's affidavit evidence filed on behalf of the applicant, and on Mr. Wilton's testimony elicited at his cross-examination. The opponent might, of course, have requested leave to amend its pleadings pursuant to Section 40 of the *Trade-marks Regulations* after reviewing Mr. Wilton's affidavit evidence and/or oral testimony, but neglected to do so. In the circumstances, I am unable to consider grounds of opposition not pleaded: see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 at pp 19-21 (F.C.T.D.).

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 14<sup>th</sup> DAY OF JUNE, 1999.

Myer Herzig,  
Member,  
Trade-marks Opposition Board